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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Teng Soon Wee et al.
Serial No.: 09/332,756
Filed: 14 June 1999
Title: METHOD AND APPARATUS FOR PROVIDING ABLATION-FREE MARKING ON HARD DISK MEDIA
Docket No.: 16864-0013
Examiner: Mr. Jonathan Johnson **Art Unit:** 1735
Last Office Action: 14 March 2002 **Paper No.:** 11

Commissioner of Patents & Trademarks
Washington, D.C. 20231

**REQUEST FOR RECONSIDERATION
AND WITHDRAWAL OF A PREMATURE FINAL
REJECTION DATED 14 MARCH 2002**

REMARKS

All of the claims except dependant claims 3, 4, 8 and 49 were erroneously rejected on Kobsa 6,163,010 under 35 U.S.C. 102(e). The rejection of claims 35 U.S.C. 102(e) is predicated on the claimed invention being "described in a patent granted on an application for patent by another". The statute is clear and unequivocal and the Examiner has failed to meet the standard set forth in the statutes. In paper No. 9, the applicant pointed out that the principal cited reference did not teach several elements of the claims and employed a different mode of operation and stated: "Accordingly, applicants respectfully traverse the alleged teaching of the rejected claims on Kobsa."

In paper No. 10 the Examiner again failed to point out where each and every element and mode of operation that is set forth in the rejected claims is shown and described in the Kobsa reference.

For purposes of appeal and/or for amendment and of allowance the undersigned attorney of record requests that the Examiner specifically point out in Kobsa the teaching by column and lines where the following claimed elements of independent claims 1 and 46 can be found.

The preamble of claim 1 calls for marking visible surface deformations on the surface of a multi-layered workpiece including, --- at least one intermediate metallic layer, and a lower substrate". Kobsa only teaches a laser cutting system for "cutting --- a variety of materials", none of which include a metallic laminate. See Col. 8.

Element (b) of claim 1 calls for a beam conditioner responsive to said laser beam including a beam expander and collimator (see element 31 in Figs. 2 and 3). Kobsa expands at element 70 after attenuation at element 60 and has no feedback or responsive element such as applicants' elements 101 and 111.

Element (c) of claim 1 is applicants' variable beam attenuator 34 as shown in Fig. 2 and is responsive to a collimated beam 33. Kobsa has no collimated beam until he leaves his expander 72/collimator 74!

Element (d) of claim 1 calls for a beam sampler (53a) In the path of the conditioned marking beam (51, 19). See Fig. 3. Kobsa's beam sampler (80) passes about 0.1% of the beam to a monitor and reflects the 99.9% to assembly (90). See Col. 5, line 34 et seq.

Element (e) of claim 1 calls for a beam steerer (21) in the path of marking beam (19). Kobsa has no beam steerer and is limited to focusing his vertical beam with his "z" optics 38. It is well known that a 35 U.S.C. 102(e) rejection is without merit or foundation when the cited reference neither teaches or suggests a main element of a claim.

Element (e) of claim 1 calls for "melting one of said at least one intermediate metallic layers and creating visible markings in said upper carbon layer without removing carbon or metal". It is unequivocally clear that Kobsa (1) has no means for directing a marking beam onto a surface of a multi-layers workpiece; (2) has no intermediate metallic layer; (3) cannot create marking in a non-existent upper carbon layer; and (4) is inoperable for creating visible marking without removing metal or the material being cut.

Kobsa does not teach or suggest element (f) of claim 1.

The elements above that are in claim 46 also are not shown or suggested. In addition, Kobsa does not teach element (e) of claim 46 or element (g) as more specifically set forth.

In summary, all dependent rejected claims are dependent from an allowable independent claim. Applicants claim commercial success for their non-destructive non-ablative marking system used to mark magnetic memory disk on a moving transport production line.

It is premature to even discuss the rejection under 35 U.S.C. 103 because the alleged teachings of the principal reference Kobsa are grossly erroneous.

The teaching of new reference Bellar 6,163,010 is taken out of context and is respectfully traversed. (See Fig. 4, Col. 1, line 30 et seq and Col.3, lines 19 et seq.).

The newly cited reference Einstein removes material by melting and ablation. The purpose of this reference is not clear in that it is not cited in the rejection of any claim.


Should the Examiner fail to find the claimed elements and mode of operation set forth in claims 1 and 48, applicants contend the rejection is not only erroneous as to its

allegations, but depends on hindsight for the basis of the rejection and clearly violates the principals and test set forth in the MPEP and Graham v. John Deere cited therein.

In the alternative, it is obvious that the claims as now worded clearly distinguish over the cited art for the reasons set forth in paper No. 9 and this paper. There are no cited references that are capable of writing indicia on the carbon surface of multilayer magnetic disk and the claims are allowable!

Applicants respectfully request a response to the erroneous allegations for the purpose of appeal or allowance of this application.

Respectfully submitted,


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Signature

14 MAY 2002
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